BRIEF IN SUPPORT OF PETITION FOR CERTIORARI

The decision sought to be reviewed is at page 22 of the Record.

JURISDICTION

The jurisdiction of this Honorable Court is based upon Section 240 (a) of the *Judicial Code* as amended by the Acts of February 13, 1925.

QUESTION INVOLVED

Concisely stated, the question here involved is whether or not the Commissioner of Patents is a proper and an adverse party in an equitable action under Section 4915, *Revised Statutes,* brought by a trade-mark owner for rectification of the Trade-Mark Register in the protection of his own trade-mark rights.

PRINCIPAL STATUTE INVOLVED

Section 4915, *Revised Statutes,* provides that a defeated or dissatisfied applicant for patent in the Patent Office "may have remedy by bill in equity" and a decree, if entitled to it, adjudging him "entitled, according to law, to receive a patent for his invention." Such adjudication it is provided, "shall *authorize* the Commissioner to issue such patent," upon the applicant doing certain other things specified.

The Statute provides for "notice to adverse parties," and that "in all cases where there is no opposing party a copy of the bill *shall* be served on the Commissioner." It further provides that the record in the Patent Office shall, "where there are adverse parties * * be admitted

in whole or in part, on motion of either party" in the equitable action.

Section 4915, *Revised Statutes* was made applicable to trade-mark matters originating in the Patent Office and effecting the Trade-Mark Register. *Trade-Mark Act of* 1905, sec. 9, (Title 15, *U. S. Code*, sec. 89), and this Court has held that a broad and liberal construction should be given this section of the *Trade-Mark Act* to afford to each of the four classes of applicants in trade-mark matters, the same rights accorded an applicant for patent under section 4915. *American Steel Foundries* v. *Robertson, Commissioner*, 262 U. S. 209, *U. S. ex. rel. Baldwin* v. *Robertson, Commissioner*, 265 U. S. 168.

CONFLICT WITH THIS COURT

This Court, in the case of *U. S. ex rel Baldwin Co.* v. *Robertson, Commissioner, et al.*, 265 U. S. 168, explicitly determined that one of the four trade-mark applicants dissatisfied with the Commissioner's action regarding the Trade-Mark Register might maintain a bill in equity, under Section 4915, *Revised Statutes*, against the Commissioner where there was also another party to the trade-mark matter in the Patent Office.

This decision has been faithfully followed and applied by the Court of Appeals for the District of Columbia. In the cases of *Alexandrine v. Coe, Commissioner*, 63 App. D. C. 227, 71 F. (2d) 348, and *Hygienic Products Co.* v. *Coe, Commissioner*, 66 App. D. C. 98, 85 F. (2d) 274, that Court expressly considered the decision of this Court and followed it.

In this case, the Court of Appeals affirmed the Trial

Court in a *per curiam* decision on the ground that the question presented was "governed by *Coe* v. *Hobart Manufacturing Company*, 70 App. D. C. 2, 102 F. (2d) 270, and *J. C. Eno (U. S.) Limited* v. *Coe*, 70 App. D. C. 337, 106 F. (2d) 858." The last of these cases did not involve the question presented by this Petition. The bill was dismissed in that case "because of the absence of an indispensable party." The first of those cases did involve the question here presented and did decide it adversely to the position herein urged, but nowhere therein did the Court consider, refer to, or even cite the controling case of *U. S. ex rel Baldwin Company* v. *Robertson, Commissioner, supra.*

In those cases of the Court of Appeals wherein *U. S. ex rel Baldwin Co.* v. *Robertson, Commissioner, supra,* has been considered, the contention herein presented has been sustained, and only in the one case referred to, where that decision of this Court was not considered, has there been a contrary holding.

CONFLICT BETWEEN CIRCUITS

The decision sought to be reviewed is in direct conflict with the decision of the Circuit Court of Appeals for the Sixth Circuit, in the case of *Cleveland Trust Company* v. *Berry*, 99 F. (2d) 517, wherein it was held that the Commissioner of Patents is a *proper party* in an equitable action under Section 4915, *Revised Statutes*, even though there be another interested or opposing party; and in conflict with the decision of the Circuit Court of Appeals for the Thrid Circuit, in the case of *Drackett Co.* v. *Chamberlain Co.*, 81 F. (2d) 866, wherein it was held that the Commissioner is a *necessary party* in an ac-

tion under Section 4915, *Revised Statutes,* even though there be other interested or opposing parties.

IMPORTANCE OF THE QUESTION

Section 4915, *Revised Statutes,* and the Act adapting it to trade-mark causes were undoubtedly intended to give the owners of valuable trade-marks an opportunity to resort to an equitable action for a judicial determination of their rights regarding the Register of Trade-Marks.

The Register of Trade-Marks is maintained and its purity and integrity are preserved by the Commissioner of Patents. He is charged with such duties. Since there exists indefiniteness and conflict in the decisions, and no one knows, therefore, exactly what course to pursue in the protection of his valuable trade-mark and patent rights, it is extremely important that the question herein raised be definitely settled by this Court.

Aggrieved trade-mark applicants in the Patent Office have definite time limitations upon their rights to proceed further, and if a wrong course is followed, jurisdictionally, their time for further action has expired. One should be able to readily determine his forum from the statute that provides his procedure and remedy.

THE COMMISSIONER OF PATENTS IS A PROPER AND ADVERSE PARTY

Section 4915, *Revised Statutes,* provides for "remedy by bill in equity." It does not require the Commissioner of Patents, if not made a party to the equitable action, to abide by its outcome, and it does not authorize the courts

to direct the Commissioner of Patents in any respect whatsoever if he is not made a party to the equitable action. It does, however, expressly provide that the Commissioner shall be a necessary party and that a copy of the equitable bill shall be served upon him where there is no opposing party. The statute does not require the Commissioner to be made a party except in the instance recited.

The equitable action under Section 4915, *Revised Statutes*, necessarily contemplates a *case or controversy*. *Cleveland Trust Co.* v. *Berry* (C. A. 6), 99 F. (2d) 517. It requires the Commissioner to be made a party in the instance recited, and it therefore recognizes his status as a party to the equitable action. He must, therefore, be in or taking a position adverse to the plaintiff or he could not be a necessary and the only party in the equitable action.

It has been long assumed by the Commissioner and the Courts of the District of Columbia that the Commissioner is an adverse party in the one instance where he is required by the Statute to be joined. It is provided by the Statute that the record in the Patent Office shall, "where there are adverse parties * * be admitted in whole or in part, on motion of either party," and it is the general practice, when the Commissioner alone is named, for one party or the other to move for admission of the record in the Patent Office in the squitable action, and for the Court to admit it. This would not be authorized by the Statute unless the Commissioner were an adverse party.

If the Commissioner be a necessary and an adverse party in one instance under the Statute, he certainly *may* be a proper and an adverse party in another. Particularly where equitable relief against the adverse position he has taken is prayed.

Equity always does complete justice. One action in equity contemplates complete relief, and complete relief could not be given petitioner in its equitable action under Section 4915 unless the Commissioner were joined as a party. The Statute does not compel him to abide the Court's decision, and the only way to make the one action suffice is to join the Commissioner as a party.

The Court of Appeals passed the matter off, in the case of *Coe* v. *Hobart Manufacturing Co.*, 102 F. (2d) 270, by merely stating that the Commissioner did not care who did or did not register or cancel the registration of a trade-mark, and that he had no interest in a fight between persons over such matters. The frailty of this position seems readily apparent. To hold that one whose principal duty in office is the maintenance and preservation of the Trade-mark Register, has no interest in the purity and integrity of that Register, and in the observance of the rights of those who are entitled to have a mark upon it removed is to flagrantly ignore an obvious fact.

It was contended by respondents that Section 72a, Title 35, *U. S. Code*, was intended by Congress to permit the bringing of an action under Section 4915 in the Dis-

trict of Columbia against a non-resident party only where there were two or more non-resident parties, and that it was not intended to permit an aggrieved applicant to force a single non-resident party to litigate in the District of Columbia rather than the District of his residence.

In considering this contention it should be borne in mind that the Statute was adapted to trade-mark causes insofar only as they arose with respect to the *Register of Trade-Marks*. Litigation under the Statute is concerned with registration and the *Register*. The opposing party came to the District of Columbia where the *Register* is kept and where the Commissioner officially resides when he sought registration, and it seems that he would contend with ill grace in subsequently insisting that it would be a hardship to force him to litigate in the District of Columbia with respect to his position on the *Register*. We believe that Congress intended by Section 72a to give the Courts of the District of Columbia, where the *Register* is kept and where the Commissioner officially resides, jurisdiction whenever it was necessary in an equitable action under Section 4915, for complete and final adjudication of the rights of a litigant, to bring before the Court in the District all persons taking a position adverse to the rights of such litigant. In the instant case the Commissioner has taken and maintained a position adverse to petitioner, and, as petitioner contends, contrary to the Statute under which its rights are defined. Merely to state that he is not an adverse party and is without interest will not suffice.

CONCLUSION

We respectfully submit that the gravity of the question involved and the unsettled state of the decisions and their conflict justify a review by this Honorable Court of the decision complained of.

Respectfully submitted,

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